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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,963	12/05/2000	Heike Wild	IN-12062	9810

7590 06/04/2003
BASF Corporation
1609 Biddle Avenue
Wyandotte, MI 48192

EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/04/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,963

Applicant(s)

WILD ET AL.

Examiner

Melanie D. Bissett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6 and 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6 and 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

1. The request filed on 5/22/03 for Continued Examination under 37 CFR 1.114 based on parent Application No. 09/701,963 is acceptable and an RCE has been established. An action on the RCE follows.
2. The rejections based on 35 USC 103 using Kennedy and Cline et al. have been withdrawn based on the applicant's arguments. However, the provisional double patenting rejections have been maintained.
3. Note: Claim 1 now states the limitation "(iii) 20-20 mm of metal", thought by the examiner to be a typographical error. The examiner treats this limitation as "2-20 mm of metal" since the limitation is not underlined to indicate an amendment to the claim and since the original claim cited a thickness of 2-20 mm.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1, 4, and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kennedy in view of Oertel.
6. From a previous Office action:
 8. Kennedy discloses a composite structure having two outer metal layers and an intermediate elastomer core layer, where the core layer has a modulus of elasticity greater than 250 MPa, tensile and compressive strengths greater than 20 MPa, and an adhesion of at least 3 MPa (abstract). Preferably, the elastomer is compact (col. 2 lines 50-54) and has a modulus of elasticity greater than 275 MPa (col. 3 lines 56-63), an elongation greater than 50% (col. 4 lines 12-15), and an adhesion to the metal layers of at least 6 MPa (col. 4 lines 26-30). Figure 3 shows a structure having two outer metal layers of 10-mm thickness and a core polyurethane layer of 50-mm thickness. Polyurethanes of the

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invention are made by reacting an isocyanate with a polyether or polyester polyol, thus teaching reaction products of polyether polyols with isocyanates. The reference teaches a method of fabricating the composites by casting or injecting the elastomer into a cavity formed between the two outer metal layers (col. 5 lines 17-21). Thus, the reference teaches a process of preparing polyisocyanate polyaddition products between two metal layers.

7. Kennedy fails to disclose specific polyether polyol and polyisocyanate components useful in the invention. Oertel describes polyurethane cast elastomers, where diphenylmethane diisocyanate (MDI) is listed as a conventionally used isocyanate for such applications (p. 390, section 8.1.1.1). Oertel teaches that polyisocyanate isomers are mixed to achieve a desired low melting point, also teaching that polymeric MDI can be mixed into isocyanate components to lower the melting point of the component without changing isomer content. It is the examiner's position that it would have been prima facie obvious to use a mixture of MDI with polymeric MDI to lower the melting point of the isocyanate component as desired and thus improve processing conditions.

8. From a previous Office action:

11. Kennedy applies as above, failing to teach the requirement of fillers in a specified range. However, the reference does indicate that fillers may be included in the elastomer layer to reduce the thermal coefficient and reduce cost of the layer (col. 4 lines 39-46). Therefore, it is the examiner's position that it would have been prima facie obvious to include fillers in any amount necessary to reduce the thermal coefficient and the cost of the elastomer layer.

Double Patenting

9. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

10. Claims 2-3 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 and 3 of copending Application No. 09/701,905. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1, 4, and 6-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 and 3-6 of copending Application No. 09/701,905. Although the conflicting claims are not identical, they are not patentably distinct from each other because of substantial overlap. Copending claim 1 parallels present claim 2, differing from present claim 1 by limitations drawn to a specific polyether polyol mixture. It is the examiner's position that

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it would have been prima facie obvious to use any polyether polyol in the copending claims in the expectancy of beneficial results. The limitations of present claims 4 and 6-7 parallel those of copending claims 3-6.

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments


14. Applicant's arguments with respect to claims 1-4 and 6-7 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb
June 2, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700